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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,904	12/13/2001	Hiroyuki Katagiri	U 013774-2	1987.

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NEW YORK, NY 10023

EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,904

Applicant(s)

KATAGIRI ET AL

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/31/05;11/08/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 have been examined. Application 10/021,904 (METHOD AND SYSTEM FOR PROVIDING ADDITIONAL SERVICES FOR PRODUCTS) has a filing date 12/13/2001 and foreign priority date 12/15/2000.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of providing additional services for products.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 1-17 are deemed to be directed to non statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Holda-Fleck (U.S. 5,729,693).

As per claim 1, Holda-Fleck teaches:

A method for providing additional services for products, wherein added values are attached to products that are distributed in a market and additional services are provided based on the added values, the method comprising:

an identification code attaching step, in which a first identification code is attached to a product that is shipped by a first company and a second identification

code is attached to a product that is shipped by a second company (see column 4, lines 29-64),

a server device preparation step, in which a server device, having a first function of separately inputting two types of identification code at a same time or at different times, a second function of confirming that one of the input identification codes is said first identification code and the other is said second identification code, and a third function of providing a predetermined service using a communication device, is prepared (see column 4, line 29 – column 5, line 7), and

a service providing step, in which when said server device is accessed from a terminal device that is operated by a user, said server device is made to execute said first function and thereby made to input identification codes from said terminal device, said server device is made to execute said second function and thereby made to confirm the input identification codes, and under a condition that a confirmation has been obtained, said server device is made to execute said third function and thereby made to provide said predetermined service to said user (see column 4, line 29 – column 5, line 8).

As per claim 2, Holda-Fleck teaches:

A method for providing additional services for products, wherein added values are attached to products that are distributed in a market and additional services are provided based on the added values, the method comprising:

an identification code attaching step, in which a first identification code is attached to a product that is shipped by a first company and a second identification

code is attached to a product that is shipped by a second company (see column 4, line 29 – column 5, line 7),

a server device preparation step, in which a server device, having a first function of inputting an identification code, a second function of confirming that an input identification code is either said first identification code or said second identification code, and a third function of selectively providing a service of a first attribute or a service of a second attribute using a communication device, is prepared (see column 4, line 29 – column 5, line 7), and

a service providing step, in which when said server device is accessed from a terminal device that is operated by a user, said server device is made to execute said first function and thereby made to input an identification code from said terminal device, said server device is made to execute said second function and thereby made to confirm an input identification code, and under a condition that an input of one of either said first identification code or said second identification code has been confirmed, said server device is made to execute said third function and thereby made to provide a service of said first attribute to said user, while under a condition that an input of both said first identification code and said second identification code has been confirmed, said server device is made to execute said third function and thereby made to provide a service of said second attribute to said user (see column 4, line 24 – column 5, line 7).

As per claim 3, Holda-Fleck teaches:

A method for providing additional services for products, wherein added values are attached to products that are distributed in a market and additional services are provided based on the added values, the method comprising:

an identification code attaching step, in which a first identification code is attached to a product that is shipped by a first company and a second identification code is attached to a product that is shipped by a second company (see column 4, line 29 – column 5, line 40),

a server device preparation step, in which a server device, having a first function of inputting an identification code, a second function of confirming that an input identification code is either said first identification code or said second identification code, and a third function of selectively providing a service of a first attribute, a service of a second attribute, or a service of a third attribute using a communication device, is prepared (see column 4, line 29 – column 5, line 40), and

a service providing step, in which when the server device is accessed from a terminal device that is operated by a user, said server device is made to execute said first function and thereby made to input an identification code from said terminal device, said server device is made to execute said second function and thereby made to confirm an input identification code, and under a condition that an input of said first identification code has been confirmed, said server device is made to execute said third function and thereby made to provide a service of said first attribute to said user, while under a condition that an input of said second identification code has been confirmed, said server device is made to execute said third function and thereby made to provide a

service of said second attribute to said user, and under a condition that an input of both said first identification code and said second identification code has been confirmed, said server device is made to execute said third function and thereby made to provide a service of said third attribute to said user (see column 4, line 24 – column 5, line 40).

As per claim 4, Holda-Fleck teaches:

A method for providing additional services for products as set forth in claim 1, wherein:

when by the first function of the server device, both the first identification code and the second identification code have been input, a content of a service provided by the third function of the server device is changed according to an order of input of the two types of identification code (see column 4, line 29 – column 5, line 40).

As per claim 5, Holda-Fleck teaches:

A method for providing additional services for products as set forth in claim 1, wherein:

a plurality of patterns are prepared for one of either or both the first identification code and the second identification code and the content of the service provided by the third function of the server device is changed according to the pattern of the identification code that has been input (see column 4, line 63 – column 5, line 8).

As per claim 6, Holda-Fleck teaches:

A method for providing additional services for products, wherein added values are attached to products that are distributed in a market and additional services are provided based on the added values, the method comprising:

an identification code attaching step, in which identification codes, each of which is unique to each of companies, are attached respectively to the products shipped by the n companies, a server device preparation step, in which a server device, having a first function of separately inputting each of a plurality of types of identification code at a same time or at different times, a second function of confirming that respective identification codes that have been input are said identification codes of said respective companies, and a third function of providing a predetermined service using a communication device, is prepared (see column 4, line 24 – column 5, line 40), and

a service providing step, in which when said server device is accessed from a terminal device that is operated by a user, said server device is made to execute said first function and thereby made to input identification codes from said terminal device, said server device is made to execute said second function and thereby made to confirm that identification codes that have been input are identification codes of all or part of said n companies, and under a condition that a confirmation has been obtained, said server device is made to execute said third function and thereby made to provide said predetermined service to said user (see column 4, line 24 – column 5, line 40).

As per claim 8, Holda-Fleck teaches:

A system for providing additional services for products, which has functions of attaching added values to 5 products that are distributed in a market and providing additional services based on the added values, the system is comprised of:

a first identification code generating device, which generates a first identification code, a second identification code generating device, which generates a second identification code,

a first identification code attaching device, which attaches said first identification code to a product that is shipped by a first company,

a second identification code attaching device, which attaches said second identification code to a product that is shipped by a second company, and

a service providing device, which inputs two different types of identification code separately at a same time or at different times from a user, and upon confirming that one of identification codes that have been input is said first identification code and the other is said second identification code, provides a predetermined service to said user.

The same rejection applied to claim 1 is applied to claim 8.

As per claim 9, Holda-Fleck teaches:

A system for providing additional services for products, which has functions of attaching added values to products that are distributed in a market and providing additional services based on the added values, the system is comprised of:

a first identification code generating device, which generates a first identification code, a second identification code generating device, which generates a second identification code, a first identification code attaching device, which attaches said first identification code to a product that is shipped by a first company,

a second identification code attaching device, which attaches said second identification code to a product that is shipped by a second company, and

a service providing device, which has functions of inputting an identification code from a user and confirming that an identification code that has been input is said first identification code or said second identification code, provides a service of a first attribute under a condition that one of either said first identification code or said second identification code has been input, and provides a service of a second attribute under a condition that both said first identification code and said second identification code have been input. The same rejection applied to claim 2 is applied to claim 9.

As per claim 10, Holda-Fleck teaches:

A system for providing additional services for products, which has functions of attaching added values to products that are distributed in a market and providing additional services based on the added values, the system is comprised of:

a first identification code generating device, which generates a first identification code, a second identification code generating device, which generates a second identification code, a first identification code attaching device, which attaches said first identification code to a product that is shipped by a first company,

a second identification code attaching device, which attaches said second identification code to a product that is shipped by a second company, and

a service providing device, which has functions of inputting an identification code from a user and confirming that an identification code that has been input is said first identification code or said second identification code, provides a service of a first attribute under a condition that said first identification code has been input, provides a service of a second attribute under a condition that said second identification code has

been input, and provides a service of a third attribute under a condition that both said first identification code and said second identification code have been input.

The same rejection applied to claim 3 is applied to claim 10.

As per claim 11, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

when both the first identification code and the second identification code have been input from a user, a content of the service provided by the service providing device is changed according to an order of input of the two types of identification code. The same rejection applied to claim 4 is applied to claim 11.

As per claim 12, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

a plurality of patterns are prepared for one of either or both the first identification code and the second identification code, and a content of the service provided by the service providing device is changed according to a pattern of an identification code that has been input. The same rejection applied to claim 5 is applied to claim 12.

As per claim 14, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

one of either or both the first identification code attaching device and the second identification code attaching device has a function of printing an identification code onto a package of a product to be shipped (see column 4, lines 30-43).

As per claim 15, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

one of either or both the first identification code attaching device and the second identification code attaching device has a function of adding an object, on which an identification code is printed, inside a package of a product to be shipped (see column 4, lines 29-43).

As per claim 16, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

the service providing device has a function of communicating with the first identification code generating device and the second identification code generating device and is arranged to perform a confirmation process concerning an input identification code by inquiring with the first identification code generating device and the second identification code generating device (see column 4, line 29 – column 5, line 40).

As per claim 17, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

the first identification code generating device and the second identification code generating device have functions of generating the first identification code and the function of generating the second identification code, respectively, based on a predetermined algorithm, and the service providing device is arranged to perform a confirmation process concerning an input identification code based on said predetermined algorithm (see column 6, lines 23-32).

As per claim 18, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

the service providing device is made of a server device connected to a network and is arranged to input identification codes from terminal devices operated by users via the network and provide services to the terminal devices operated by said users via the network (see column 5, line 60 – column 6, line 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holda-Fleck (US 5,729,693) in view of Cote et al (US 2002/0090986).

As per claim 7, Holda-Fleck teaches:

A method for providing additional services for products as set forth in claim 1, but fails to teach wherein: as a service to be provided by the third function of the server device, a provision of a game, a provision of a quiz, or a provision of fortune-telling information to the terminal device that is operated by the user is carried out. However, Cote teaches a system that allows users to play games by inputting in a computer an initiator code (see paragraph 11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Holda-Fleck would allow customers to participate in games by inputting products' codes into terminal devices, as taught by Cote. Manufacturers would use the playing of games as a incentive to customers to purchase the manufacturers' products.

As per claim 13, Holda-Fleck teaches:

A system for providing additional services for products as set forth in claim 8, wherein:

as a service to be provided by the service providing device, a provision of a game, a provision of a quiz, or a provision of fortune-telling information to the user is carried out. The same rejection applied to claim 7 is applied to claim 13.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone

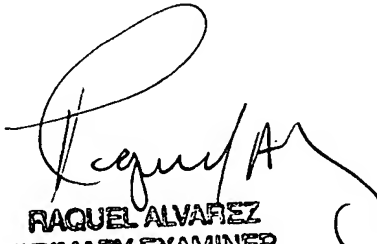
number for the organization where this application or proceeding is assigned is 703-872-9306.

The Examiner is scheduled to move to the new Alexandria office in April 2005 (or later). The Alexandria phone number would be 571-272-6720 and RightFax number 571-273-6720. The examiner's supervisor, Eric W. Stamber, new Alexandria number would be 571-272-6724. The current numbers would be in service until the move.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
February 28, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER